



**UNITED STATES DEPARTMENT OF COMMERCE**

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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
08/707, 991	03/11/96	BRYAN	D

J WINSLOW YOUNG  
PO BOX 1088  
CENTERVILLE UT 84014-5088

33M1/1128

EXAMINER	
TUCKER, G	
ART UNIT	PAPER NUMBER
3309	

DATE MAILED: 11/28/97

**Please find below a communication from the EXAMINER in charge of this application.**

Commissioner of Patents

<b>Office Action Summary</b>	Application No. <b>08/707,991</b>	Applicant(s) <b>Bryan</b>
	Examiner <b>Guy V. Tucker</b>	Group Art Unit <b>3309</b>

Responsive to communication(s) filed on Jul 31, 1997

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

#### Disposition of Claims

Claim(s) 1-12, 14, 15, and 17-30 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

Claim(s) 1-12, 14, 15, 17-22, and 24-30 is/are allowed.

Claim(s) 23 is/are rejected.

Claim(s) \_\_\_\_\_ is/are objected to.

Claims \_\_\_\_\_ are subject to restriction or election requirement.

#### Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. § 119

Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All  Some\*  None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

#### Attachment(s)

Notice of References Cited, PTO-892

Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Interview Summary, PTO-413

Notice of Draftsperson's Patent Drawing Review, PTO-948

Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit 3309

The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

It does not state that the person making the oath or declaration in a continuation-in-part application filed under the conditions specified in 35 U.S.C. 120 which discloses and claims subject matter in addition to that disclosed in the prior copending application, acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56 which occurred between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

The following non-statutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the right to exclude granted by a patent. In re Sarett, 327 F.2d 1005, 140 USPQ 474 (CCPA 1964); In re Schneller, 397 F.2d 350, 158 USPQ 210 (CCPA 1968); In re White, 405 F.2d 904, 160 USPQ 644 (CCPA 1969); In re Thorington, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970) In re Van Ornam, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); In re Longi, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and In re Goodman, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) would overcome an actual or provisional rejection on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37

Art Unit 3309

CFR 1.78(d).

Claim 23 is rejected under the judicially created doctrine of double patenting.

The subject matter recited in claim 23 of the present patent application - “comprising ABCY” - is fully disclosed in the patent (or application if this is a provisional rejection). The allowance of claim 23 would extend the rights to exclude already granted in 5,498,262 - that right to exclude covering the invention “comprising ABCX”. The transitional phrase “comprising” does not exclude the presence of elements other than A, B, C, X in the claim. Because of the phrase “comprising” the patent not only provides protection to ABCX but also extends patent coverage to the disclosed combination - ABCXY. Likewise, if allowed, the claim(s) of the present application , because of the phrase “comprising”, not only would provide patent protection to the claimed combination ABCY but would also extend patent coverage to the combination ABCXY - already disclosed and covered by ‘262. Thus, the controlling fact is that patent protection for the invention, fully disclosed in and covered by ‘262, would be extended by the allowance of claim 23 in the present application.

Furthermore, there is no apparent reason why applicant was prevented from presenting claim 23 in the application during the prosecution of ‘262.

Claims 1-12, 14, 15, 17-22, and 24-30 are allowable over the prior art of record.

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

Art Unit 3309

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to examiner Guy Tucker at telephone number (703) 308-3271. Examiner Tucker can normally be reached on Monday through Thursday from 7:00 AM to 5:30 PM, Eastern Time.

If attempts to reach the examiner by telephone are unsuccessful, examiner Tucker's supervisor, Michael Buiz, can be reached at (703) 308-0871. The fax number for Group 3300 is (703) 305-3590 or 3591.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group 3300 receptionist at (703) 308-0858.

GVT  
November 24, 1997

  
GUY V. TUCKER  
PRIMARY EXAMINER  
GROUP 3300